

Due Date: February 5, 2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

| | | |
|--|---|-------------------------|
| In re Application of: |) | |
| |) | |
| Inventor: Kenneth L. Davis |) | Examiner: Tran, Quoc A. |
| |) | |
| Serial #: 09/862,884 |) | Group Art Unit: 2176 |
| |) | |
| Filed: May 21, 2001 |) | Appeal No.: _____ |
| |) | |
| Title: METHOD AND APPARATUS FOR |) | |
| <u>ANNOTATING A SEQUENCE OF FRAMES</u> |) | |

REPLY BRIEF OF APPELLANTS

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In accordance with 37 C.F.R. §41.41, Appellants hereby submit their Reply Brief on Appeal from the final rejection of claims 1-24 of the above-identified application, as set forth in the final Office Action mailed May 19, 2006 and in response to the Examiner's Answer dated December 5, 2006, as well as in response to the Examiner's Answer dated February 9, 2007.

No fee is required for filing this Reply Brief. However, the Office is authorized to charge any necessary fees or credit any overpayments to Deposit Account 50-0494 of Gates & Cooper LLP.

I. ARGUMENTS

A. Independent claims 1, 9, and 17 Are Patentable Over the Cited Art

In response to the previously submitted arguments, the Examiner's Answer on page 13 refers to Wistendahl and notes that the user marks a position of an object in a key frame by designating a marker MK in a central position within an outline OL in a frame and that in order for the user to outline an OL around an airplane, the user must click an MT button of a tool bar, where it appears in succeeding frames until a last frame. The Answer further notes on page 13 that the steps of stop and go would be appreciated by a person of ordinary skill in the art. The Answer then continues and states that the term "automatically" is not defined as "without a human intervention" and recites Appellant's paragraphs [0022]-[0023].

Appellants respectfully disagree with and traverse such assertions. Firstly, Appellants note that under MPEP §2142, the claimed invention must also be examined as a whole and whether the "whole" claimed invention would have been obvious at the time of invention (see MPEP §2142). Further, MPEP 2141.01 provides that in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). Appellants claims are very specific in what they recite and must be examined as a whole. The claims first explicitly provide for obtaining annotation information that consists of an identification of a frame within a sequence of frames, an annotation, and a location on the frame. The frames are then consecutively displayed. The claims then provide for determining when the identified frame is displayed and automatically pausing the display of the sequence at the identified frame. It is this step that the rejection is improperly rendering obvious by Wistendahl.

The Examiner's rejections and Answer are asserting that this step is being performed by the user. In other words, the Office Action is asserting that the user is determining when the identified frame is displayed and the user selects a button to pause the display. Such an obviousness determination is wholly without merit. Appellants note that the method of claim 1 is a computer implemented method. Appellants further note that apparatus of claim 8 specifically recites that the

step is performed by a computer program. Further, claim 8 provides that a method in a computer is performing the step. To assert that a user is performing the particular step removes all meaning of the claimed step. In this regard, if a user is performing the determining step, then it wouldn't be a computer implemented method. Further, there would be no purpose or use for utilizing the word automatically in the claims if a user were performing the step.

Appellants direct the attention of the Board to the sequence of claimed elements. Namely, the first step is to consecutively display the one or more sequence of frames followed by a determination of when the identified frame is displayed and automatically pausing the display of the sequence at the identified frame. Instead of teaching such a specific and explicit set of claim steps, the Office Action and Answer is attempting to assert that the user drawing an outline around an object and displaying the outline around the object until the object disappears is within the scope of the claims. Such a teaching is wholly without merit. Again, as recited in the Appeal Brief, rather than teaching the pausing of the sequence of the display and continuing to display when the USER elects to proceed (note the use of the term user in the last claim step is explicitly recited while it is not recited in the earlier steps), is not even remotely similar to the Wistendahl's user stopping a display, drawing an object that is tracked and displayed throughout a sequence of frames. Instead, since Wistendahl teaches the continuous display of the object, Wistendahl actually teaches away from the present invention.

The Answer insists that the term automatically does not mean "without a human intervention" and recites paragraphs of Appellants specification for support of such an assertion. Appellants refer the Board to page 9, line 22-page 10, line 2 which provide:

At step 208, a determination is made regarding whether the frame is the identified frame. If not, the process continues and the next frame is displayed at step 206. If the frame is the identified frame, frame annotation program 108 pauses in displaying the sequence of frames at step 210. At step 212, the annotation is displayed/played at the location specified. Thereafter, the sequence of frames may continue to be displayed upon the user electing to proceed (e.g., by selecting a "Play" button or other key on a keyboard or input device that acts to un-pause the frame sequencing).

Appellants also refer the Board to the context and description of the entire application. In this regard, the annotation information specifies a particular frame, an annotation and a location on the frame to display the annotation. The application refers to specific examples where the

annotation information is specified in XML. If all of the annotation information is specified in XML (including the identification of the particular frame), and the claims provide for displaying the sequence of frames until the frame identified in the XML has been displayed, then it would be impossible for such a teaching to also mean the user manually stopping the display as the Examiner suggests.

Again, the Office Action is attempting to assert that the term “automatic” imparts no additional meaning to the claims other than a computer program performing what the user tells it to perform. If such a meaning were true, then all actions performed by a computer are always performed automatically since they are often without user input. Accordingly, the term automatically would impart no additional meaning to the present claims. Appellants note that the term “automatically” is not used in numerous locations of the claims, but is only used when stating that the sequence is automatically paused and in accordance with standard claim interpretation, such a claim term must have some meaning.

The Answer continues on pages 15 and 16 with the assertion that the claimed step of displaying the annotation while the sequence of frames is paused is equivalent to Wistendahl’s user initially stopping the frames and marking a position of an object with a marker. Such a teaching is inconsistent with the sequence and details of the present claims. First, the claims provide for obtaining annotation information that includes the identification of the frame, the annotation, and the location on the frame to display the annotation. The claims then explicitly provide for pausing the display at the frame identified in the annotation information. Accordingly, the annotation information must be obtained prior to the pausing of the display. The claims then provide for displaying the annotation information on the identified frame at the specified location (i.e., which is all specified in the annotation information). Wistendahl clearly provides for the user manually stopping the sequence and then manually marking the object. Thus, there is no use of any annotation information before Wistendahl’s user has marked the object. Instead, the marking of the object would create the marking. Thus, Wistendahl cannot possibly teach the obtaining of the annotation information and the pausing and displaying (in that order) (based on such annotation information) since Wistendahl does not have any annotation information or an identified frame prior to manually stopping the sequence and marking the

object. Thus, the initial marking of the object cannot teach the claimed elements as asserted by the Examiner.

In this regard, the only time where such already marked objects are used in Wistendahl is when the hot spot is displayed in the sequence. However, as set forth in the Appeal Brief, such a displayed hotspot in Wistendahl does not occur while a sequence is paused but is always displayed without pausing the sequence.

The Answer (on page 15) continues and again relies on Russel which is in a completely different field of art (that of annotating a 3D model and not a sequence of frames). Appellants note that displaying a multimedia function of Russell when a pointer is activated in a 3D model has absolutely no relevance and is not even remotely similar to either Wistendahl or the claimed invention. The Answer asserts that Wistendahl and Russel are in the same field of endeavor without any support from the specification of either Wistendahl or Russel. Appellants assert that such an assertion is wholly without merit. Again, the two references are from completely different fields of endeavor and there would be no use or need to look to Russel when performing the steps specified in Wistendahl and vice versa. Accordingly, there is no motivation to combine the two references.

B. Independent claims 1, 9, and 17 Are Patentable Over the Cited Art

As stated above, these steps specify that all of the annotation information is in XML. As set forth above, the annotation information specifies a particular frame, an annotation and a location on the frame to display the annotation. The application refers to specific examples where the annotation information is specified in XML. If all of the annotation information is specified in XML (including the identification of the particular frame), and the claims provide for displaying the sequence of frames until the frame identified in the XML has been displayed, then it would be impossible for such a teaching it also mean the user manually stopping the display as the Examiner suggests.

In this regard, the mere recitation of Gupta to support the explicit and specific use of XML in the context of the remaining elements of the claims is meritless. Appellants further refer to the Board to the arguments set forth in the original Appeal Brief.

II. CONCLUSION

In light of the above arguments, Appellant respectfully submit that the cited references do not anticipate nor render obvious the claimed invention. More specifically, Appellant's claims recite novel physical features which patentably distinguish over any and all references under 35 U.S.C. §§ 102 and 103. As a result, a decision by the Board of Patent Appeals and Interferences reversing the Examiner and directing allowance of the pending claims in the subject application is respectfully solicited.

Respectfully submitted,

GATES & COOPER LLP
Attorneys for Applicant(s)

Howard Hughes Center
6701 Center Drive West, Suite 1050
Los Angeles, California 90045
(310) 641-8797

Date: March 26, 2007

By: /Jason S. Feldmar/
Name: Jason S. Feldmar
Reg. No.: 39,187

JSF/bjs

G&C 30566.128-US-01